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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,013	07/10/2001	Wei-Sing Chu	2313-117	8860

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EXAMINER

CHIN, CHRISTOPHER L

ART UNIT PAPER NUMBER

1641

DATE MAILED: 06/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/901,013

Applicant(s)

CHU, WEI-SING

Examiner

Christopher L. Chin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on the request for RCE file on 11/18/05.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 80,82,83 and 92-104 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 80,82,83, and 92-104 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/15/06 has been entered.

Claim Rejections - 35 USC § 112

2. Claims 80, 82, 83, and 92-104 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 80 and 92 are vague and confusing because it is not clear as to how the sample or tissue is related to the robotic system (claim 80) or system (claim 92). Unlike other components that may comprise a robotic system or system, such as an arm, or claw, or controller, a sample or tissue are not components of robots or robotic systems and thus is not clear as to how a sample or tissue can be a limitation/component of a robotic system or system.

In response to this rejection, Applicants refer to Figure 7 of the application which illustrates the relationship of the tissue sample and transducers as they are moved from a first, a second, and subsequent reaction chambers to effect fixation of a tissue

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sample. Applicants assert that the present claims make clear the relationship between the tissue sample, the transducer and the reaction chambers for fixing the sample.

Applicant's arguments have been considered but are not convincing. The specification may define the relationship of the tissue sample to the other components of the robotic system during use of the robotic system but the instant claims are not directed to a method of using a robotic system that includes a tissue sample. The last part of claim 80 that describes movement of the tissue sample from reaction chamber to reaction chamber is not a limitation of the claimed robotic system because it only sets forth an intended use of the robot, transducer, and tissue sample. Furthermore, while the claims must be read in light of the specification, the claims must still clearly set forth the interrelationships of the components of the robotic system (or system). The claims fail to describe the relationship of the tissue sample to the other components of the robotic system (or system). Also, with respect to new claims 97-100, claim 80 fails to positively recite the presence of any reaction chambers in the claimed robotic system. As recited, the reaction chambers are only present for an intended use of the claimed robotic system. Since the reaction chambers are not part of the claimed robotic system, the limitations of claims 97-100 are also not part of the claimed robotic system.

3. Claims 80, 82, 83, and 92-104 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to

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reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification, as originally filed, does not provide adequate written description for the robotic system or system recited in claims 80, 82, 83, and 92-104. Page 9 of the instant specification discloses that Figure 7 represents a system showing solutions, each in a different container. The complete system of tissue, ultrasound generator, transducer, sensors, and CPU can be moved from one container to the next. The robotic system that controls the movement of the components in Figure 7 is not shown. Figures 6A and 6B show block diagrams of the robotic system that is to be used in Figure 7. However, there is no specific description of the components that comprise the robotic system of Figures 6A and 6B in the instant specification. Example 7 on page 29 of the specification discusses the sensors, transducers, CPU, etc shown in Figures 6A and 6B but there is no detailed disclosure of the robotic system that is required to move sample or tissue and an ultrasound transducer as recited in claims 80, 82, 83, and 92-104.

In response to this rejection Applicants argue that the use of robotic systems in clinical labs for processing of tissue samples was well known at the time of the present application. Applicants assert that it is not necessary to spell out every detail of the invention in the specification and that only enough description must be included to convince a person of skill in the art that the inventor possessed the subject matter of the claims.

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Applicant's arguments have been considered but are not convincing. To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. The instant specification does not provide sufficient disclosure of the robotic system to suggest to one of ordinary skill in the art that the inventors had possession of the claimed subject matter. There may have been numerous robotic systems in the prior art at the time of filing of the instant application; however, the instant specification lacks any detailed description of any specific robotic system that can perform the functions recited in the specification and claims.

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher L. Chin whose telephone number is (571) 272-0815. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on (571) 272-0823. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Christopher L. Chin
Primary Examiner
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6/20/06